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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,563	02/11/2004	Johannes Hendrikus Maria Spruit	PHN 17-477A	2783

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EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,563

Applicant(s)

SPRUIT ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/577,546.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/11/04</u> . | 6) <input type="checkbox"/> Other: ____ |

1) This application is a Continuation Application of S/N 09/577,546, filed 5/24/2000 and now is US 6,714,508; which has foreign priority claimed to foreign application filed in European Patent Office identified as:

- E.P.O, 99201748.3, filed on 6/02/1999.

2) The preliminary amendment filed 2/11/2004 is acknowledged. New claims 12-16 have been added.

3) The I.D.S filed 2/11/2004 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

4) The specification is *not in proper format* of US patent application. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT

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- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5) The disclosure is objected to because of the following informalities: The specification and the drawing contains both track and recording carrier label as "10".

Appropriate correction is required.

6) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7) Claims ~~1-11~~, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,714,508. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-11 in this instant application and claims 1-11 of U.S. Patent No. 6,714,508 recite the same features with each other except that one recites the phase of the wobble at the information positions is adapted to the presence of a pit at such a predetermined position, and the other recites the phase of the wobble at the information positions depends on the presence of a pit at such a predetermined position. However, this difference is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

Claims 13 and 14 in this instant application and claims 1-11 of U.S. Patent No. 6,714,508 recite the same features with each other

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except that one recites the tracks having two borders, at least one of borders having wobble with a phase and the other recites the track being provided with wobbled grooves. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

8) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

9) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10) Claims 1-5,7,11,13,14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by VAN DEN et al (6,295,270).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.102(e). This rejection under 35 U.S.C.102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is

thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

VAN DEN et al discloses an optical recording carrier as claimed in claim 1, comprising:

a recording layer having substantially parallel tracks for recording information in a pattern of optically detectable marks (Fig.2A, tracks 10,11,12 and 13), the tracks being provided with wobbled grooves and predetermined positions at regular intervals along the tracks (Fig.2A, tracks 10,11,12 and 13 are wobbled at regular interval);

part of the predetermined positions forming information positions on which information is stored in the form of pits (Fig.2A, pits 19 and 20);

characterized in that the phase of the wobble at the information positions is adapted to the presence of a pit at such a predetermined position and the wobble changes phase between each two subsequent predetermined positions of which one of the positions contains no pit and the other position is an information position containing a pit (Fig.2A, the phase change at present pit 19 and at no pit 20).

As to claim 2, VAN DEN et al shows the number of periods of the wobble on the record carrier having a phase pertaining to an

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information position containing no pit is larger than the number of periods of the wobble having a different phase (column 4, lines 8-27).

As to claim 3, VAN DEN et al shows the predetermined position are arranged in cells and the first period of the wobble after the start of the cell pertains to an information position having a pit (Fig.2B, cells 14,15,16 and 17).

As to claim 4, VAN DEN et al shows the wobble has a minimum value at an information position with pit and a maximum value at an information position without pit (column 2, lines 5-16).

As to claim 5, VAN DEN et al shows the information are group in series and the wobble between series in the track direction represents information (Fig.2A, the information are group in series).

As to claim 7, VAN DEN et al shows predetermined position are arranged between neighboring grooves (Fig.3, predetermined position is land 24').

As to claims 8 and 9, VAN DEN et al shows the phase of the wobble of only one of the neighboring grooves is adapted to the presence of a pit at an information position (Fig.2A, pit 19), and wobble of both neighboring grooves are in an anti-phase (Fig.3, position 26 is in anti-phase).

As to claim 10, VAN DEN et al shows the information position are group in doublets of two neighboring predetermined positions and one pit is present in each doublet (Fig.3, one pit is present in each doublet).

As to claim 11, VAN DEN et al shows the land portions are arranged between grooves and alternately provided with pits and without pits (Fig.3, land 24').

VAN DEN et al discloses an optical recording carrier as claimed in claims 13 and 14, comprising:

an optical record carrier comprising a recording layer having substantially parallel tracks, the tracks having predetermined positions at regular intervals along the tracks (Fig.2A, tracks 10,11,12 and 13), some predetermined positions having respective pits and other predetermined positions having no pits (Fig.2A, pit 19, no pit 20);

the tracks each having two borders, at least one of the borders having a wobble with a phase (Fig.2A, tracks 10,11,12 and 13 each having two border between land and groove, the borders having wobble with a phase);

a part of the predetermined positions being information positions, information being stored at the information positions, the stored information being represented by the presence of respective pits at the information positions and the phase of the

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wobble changes depending on the presence of pits at the predetermined positions (Fig.2A, information stored as presence of pit 19, the phase of the wobble changes depending on the present of pit 19 or no pit 20).

As to claim 15, VAN DEN et al shows the border at predetermined positions having respective pits has a first phase and the border at predetermined positions having no pits has a second phase that is different than the first phase (Fig.2A, the phase at pit 19 is different with the phase at no pit 20).

11) The following is a quotation of 35 U.S.C.103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C.103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over VAN DEN et al (6,295,270).

VAN DEN et al discloses all the subject matter claimed as in claim 6, except to specifically show that the wobble is encode by phase-shift keying. Official Notice is taken that phase-shift keying are widely used in the art for encoding the wobble signal in optical disk recording system, and therefore they are old and well known. It would have been obvious to use the old and well known phase-shift keying encoding scheme such as VAN DEN et al's because, in the absence of any new or unexpected result, selecting of a known material/element based on its suitability for the intended use is deem obvious. In re LESHIN, 125 USPQ 416.

14) Claims 12 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(See form PTO-892 attached herein).

16) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TAN DINH
PRIMARY EXAMINER

August 4, 2005